



Docket No.: 1349.1254

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Masaki OGURO

Serial No. 10/721,507

Group Art Unit: 2622

Confirmation No. 6120

Filed: November 26, 2003

Examiner: Richard M. BEMBEN

For: VIDEO/AUDIO DATA RECORDING/REPRODUCING APPARATUS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed February 21, 2008, having a shortened period for response set to expire on March 21, 2008. A petition for a one-month extension of time is concurrently filed herewith, thereby extending the response due date to April 21, 2008. The following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Group 1, Claims 1-13 and 23-58**, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II, is concerned, it is believed that claims 14-22, are so closely related to elected claims 1-13 and 23-58 that they should remain in the same application.

Here, even if the Examiner considers claims 1-13 and 23-58 to be a separate invention from claims 14-22, or a separate combination/sub-combination, the Applicants respectfully submit that all pending claims describe sufficiently overlapping subject matter that they should be considered together.

Further, the Office Action fails to address the second required criteria for restriction, i.e., that such a search for the different groups of claims will result in a serious burden on the Examiner.

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Here, MPEP § 803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §§ 802.01, 806.04, 808.01) or distinct as claimed (see MPEP §§ 806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §§ 803.02, 806.04(a)-806.04(i), 808.01(a) and 808.02).

In this regard, to meet the required "serious burden" requirement, the Office Action cites different subclasses that will need to be searched. However, it is respectfully submitted that both subclasses will need to be searched for either of claims 1-13 and 23-58 and claims 14-22. Thus, there cannot be any serious burden for performing such a search.

Further, merely because different subclasses have been cited is not sufficient evidence in the record that a search of the same will be a serious burden. Again, as noted above, both subclasses will need to be searched for both groups of claims.

Lastly, regarding the required serious burden criteria, it is respectfully submitted that the Examiner has not set forth any particular evidence in the record supporting the stated conclusion of the serious burden and different searches.

III. Conclusion

Thus, it is respectfully submitted that the outstanding restriction requirement is improper and all claims should be maintained under review.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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By: 

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Date: April 18, 2008

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